

### **REMARKS**

Applicants were required to elect one of the following groups of inventions.

Applicants thank the Examiner for the courtesy of a telephone conference on February 14, 2005 to clarify the groups. The groups are correctly listed below:

- I. Claims 1-5, 13-18, and 41-45 drawn to crystalline pantoprazole and to pharmaceutical compositions and a method of using the same.
- II. Claims 6-12 and 19-25 drawn to processes of preparing crystalline pantoprazole.
- III. Claims 26 and 41-45 drawn to amorphous pantoprazole and to pharmaceutical compositions and a method of using the same.
- IV. Claim 27-31 drawn to processes of preparing amorphous pantoprazole.
- V. Claims 32, 34, 36, 39, and 40 drawn to processes for preparing a salt of pantoprazole.
- VI. Claims 33, 35, 37, 38, and 46-50 drawn to a salt of pantoprazole and to pharmaceutical compositions and a method of using the same.

In response to the restriction requirement, Applicants provisionally elect, with traverse, the claims of Group I, claims 1-5, 13-18, and 41-45, for examination in this application. Applicants expressly reserve the right to file one or more divisional or continuation application(s) directed to the non-elected subject matter.

This election is made with traverse because it is believed that the claims can be prosecuted as a single group. There are two criteria for a proper restriction requirement: “(A) The inventions must be independent or distinct as claimed; AND (B) There must be a serious burden on the Examiner if restriction is required.” *MPEP* §803 (8th ed. Feb. 2003 rev.) (emphasis added) (citations omitted). “If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct invention.” *MPEP* §803. Applicants believe that examining the claims as single group would not place an undue burden on the Examiner. The claims relate to solid states of pantoprazole. Accordingly, Applicants respectfully submit that a diligent search of prior art to claims of Group I would most likely reveal the prior art most relevant to the other groups.

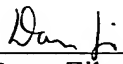
Also, Applicants note that when a product claim from the elected group is found allowable, the non-elected method claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with *MPEP* § 821.04. Thus, because non-elected method claims 6-12, 19-25, and 32-40 depend from elected product claims 1 and/or 13, these method claims will be rejoined upon a finding that the product claims are allowable.

**CONCLUSION**

Timely action on the merits is respectfully requested. If the Examiner believes that issues may be resolved by a telephone interview, the Examiner is invited to telephone the undersigned at the number below. The undersigned may also be contacted by email at [dziker@kenyon.com](mailto:dziker@kenyon.com).

Respectfully Submitted,

Date: 2-14-05

  
\_\_\_\_\_  
Dana Ziker  
Reg. No. 54,567

KENYON & KENYON  
1500 K Street, NW  
Washington D.C. 20005  
Direct Dial: (202)-220-4215  
Fax: (202)-220-4201